

REMARKS

Claims 1-20 were pending in this application.

Claims 1-4, 7-10, 13-16, and 19 have been rejected.

Claims 5, 6, 11, 12, 17, 18, and 20 have been objected to.

Claim 1 has been amended as shown above.

Claims 1-20 remain pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicant thanks the Examiner for the indication that Claims 5, 6, 11, 12, 17, 18, and 20 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims. Because the Applicant believes that the remaining claims in this application are allowable, the Applicant has not rewritten Claims 5, 6, 11, 12, 17, 18, and 20 in independent form.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-4, 7-10, 13-16, and 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,734,872 to Eager et al. ("*Eager*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as

they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Eager recites a system and method for controlling the temperature of an electronic component during testing of the component. (*Abstract*). The system includes an air compressor 22, an air dryer 24, a refrigeration unit 26, and a heating unit 28. (*Figures 1 and 5*). The air compressor 22 draws in air and compresses the air. (*Col. 5, Lines 23-25*). The air dryer 24 reduces the dew point of the compressed air, the refrigeration unit 26 chills the compressed air, and the heating unit 28 heats the compressed air. (*Col. 5, Lines 39-45*). The compressed air is then blown onto a device under test 20, which is mounted on a tester board 30, encased in a cap 32, and disposed in an enclosure 34. (*Col. 5, Lines 25-32*).

First, the Office Action relies on the cap 32, the enclosure 34, and the tester board 30 of *Eager* as anticipating the “housing” recited in Claims 1, 7, and 13. (*Office Action, Page 2, Last paragraph*). The Office Action also relies on a personal computer in *Eager* as anticipating the “controller” recited in Claims 1, 7, and 13. (*Office Action, Page 2, Last paragraph*). In addition, the Office Action relies on an inherent power supply in the personal computer as anticipating the “power supply” recited in Claim 13. (*Office Action, Page 2, Last paragraph – Page 3, First paragraph*).

Claims 1, 7, and 13 recite that a “housing” includes a “controller.” *Eager* clearly recites that the personal computer does not form part of the cap 32, the enclosure 34, and the tester

board 30. Rather, *Eager* specifically recites that the personal computer represents an “external controller.” (*Col. 10, Lines 28-34*). As a result, *Eager* fails to anticipate a “housing” that includes a “controller” as recited in Claims 1, 7, and 13. Also, the power supply in the personal computer of *Eager* does not form part of the cap 32, the enclosure 34, or the tester board 30. Because of this, *Eager* fails to anticipate a “housing” that includes a “power supply” as recited in Claim 13.

Second, Claims 1, 7, and 13 recite that an “air machine” and a “housing” are associated to “form an at least substantially air-tight chamber ensconcing the received device under test.” *Eager* lacks any mention that the cap 32, enclosure 34, and tester board 30 form an “at least substantially air-tight chamber” around the device under test 20.

The Patent Office also cannot establish that this feature is inherent in *Eager*. The system of *Eager* operates by having the air compressor 22 draw air into the system, and compressed air is then blown onto the device under test 20. The cap 32, enclosure 34, and tester board 30 could not form an “at least substantially air-tight chamber” around the device under test 20. The air compressor 22 of *Eager* is constantly drawing air into the system, and the new air must somehow displace the previous air blown onto the device under test 20. If the previous air blown onto the device under test 20 could not escape from the enclosure 34, the new air blown into the enclosure 34 would cause the air pressure inside the enclosure 34 to continuously increase until the enclosure 34 ruptured. This is clearly not how the system of *Eager* operates. Because of this, the Patent Office cannot establish that *Eager* anticipates associating an “air machine” and a “housing” to “form an at least substantially air-tight chamber ensconcing the received device

under test” as recited in Claims 1, 7, and 13.

For these reasons, *Eager* fails to anticipate the Applicant’s invention as recited in Claims 1, 7, and 13 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejections and full allowance of Claims 1-4, 7-10, 13-16, and 19.

III. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting prosecution of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

March 25, 2005



William A. Munck

Registration No. 39,308

Docket Clerk
P.O. Drawer 800889
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@davismunck.com*